

Remarks

By the above Amendment, Claims 12, 25 and 60 have been canceled; Claims 1, 3, 8, 9, 13, 15, 17, 18, 19, 24, 26, 28, 29, 30, 38, 39, 42, 44, 46, 49, 50, 55, 57, 61, 63, 64, 65 and 66 have been amended; and new Claims 68-77 have been added.

Claims 1-11, 13-24, 26-59 and 61-77 are pending in this application, of which Claims 7-11, 20-37, 47, 48 and 62 stand withdrawn from consideration as being drawn to non-elected species.

The enclosed check in the total amount of \$400 includes the sum of \$175 to cover the excess claims fee for claims added by the above Amendment, as shown in the attached "Fee Determination Record". If the enclosed fee is deficient in any manner, please charge any such deficiency to Deposit Account No. 23-0822.

Drawing

By the Office Action dated 3/16/2005, the examiner objected to the drawings with respect to Claim 13 (see also new Claim 72), the examiner stating that the second magnetic member projecting from the bottom surface of the cover and the first magnetic member recessed from the top surface of the base and including an indentation in the top surface is not shown in the drawings. Applicant notes, however, that such structure is shown in FIG. 27 of the drawing. Applicant respectfully submits that such disclosure in FIG. 27 obviates the examiner's objection to the drawing.

Applicant notes that new Claims 68, 71 and 75 recite the embodiment where the indentation is in the bottom surface, shown in FIG. 10.

Claim Objections

Applicant has amended Claims 1, 38, 49 and 63 (as well as withdrawn Claim 24) in the manner suggested by the examiner. Applicant has amended Claims 3, 39 and 50 in a manner obviating the examiner's objection to these claims; applicant points out that the antecedent bases for "thickness" and "peripheral dimensions" are set forth in the preambles of the base claims for these dependent claims. Applicant has amended Claim 17, 44 and 57 in the manner suggested by the examiner. Applicant submits that these amendments obviate the examiner's objections to Claims 1-6, 12-19, 38-46, 49-61 and 63-67.

Claims Rejections – 35 U.S.C. §103

Claims 1-6, 12-18, 38-45, 49-58, 60, 61 and 63-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Neugebauer ((U.S Patent No. 5,522,163) in view of Yeh (U.S. Patent No. 6,256,914) or Yang (U.S. Patent No. 5,167,085). Applicant respectfully traverses such rejections and requests reconsideration of this application, applicant submitting that all pending claims in this application as amended are patentable over the cited references for the reasons set forth below.

Independent Claims 1, 38, 49 and 63 (as well as withdrawn independent Claim 24) have been amended to recite applicant's projecting end portion of one of the magnetic members and the recessed other one of the magnetic members, and the aligned indentation for receiving that projecting end portion. Specifically, each of Claims 1, 38, 49 and 63 have been amended to recite that one of the first and second magnetic members includes an end portion projecting from a corresponding one of the top and bottom surfaces and that the other of the first and second magnetic members is recessed from a corresponding one of the top and bottom surfaces, and to further recite an indentation in the other of the top and bottom surfaces aligned with the other of the first and second magnetic members for receiving the end portion of the projecting magnetic member. Dependent Claims 12 and 60 have been canceled as redundant of their respective base Claims 1 and 49 as amended (and withdrawn dependent Claim 25 has been canceled as redundant of its withdrawn base Claim 24). Dependent Claims 13, 15, 17, 42, 55, 57, 61 and 64-66 have been amended for consistency with amendments to their respective base claims and/or any intervening claims. (In addition, withdrawn dependent Claims 9, 26, 28, 29 and 30 have been amended for consistency with amendments to their respective base claims and/or any intervening claims.)

The patent to Yeh teaches a picture frame formed by interposing a picture between flat surfaces of two transparent panels, the panels being held together by magnets (7) embedded in the panels, the end surfaces of each of the magnets being flush with the flat surfaces of the panels (see, for example, the cross-sectional views in FIGs. 3, 6, 9, 12, 14 and 16). The disclosure of the Yang patent does not show either the magnet (113) or the iron plate (21) as projecting from the surface of the frame members (11) or (2) in which the magnet (113) and iron plate (21) are affixed. Accordingly, neither of the Yeh or Yang references show or

suggest one of the magnetic members with an end portion projecting from the panel surface and the other magnetic member recessed from the other panel surface, with an indentation in the other panel surface aligned for receiving the projecting magnetic member end portion.

However, after stating that “Neugebauer shows in Figures 1 and 3 that the cover includes a recess (46) that receives a protrusion/collar (36) formed on the base”, the examiner combines Yang or Yeh with Neugebauer by stating that “the magnetic members taught by Yang and Yeh *would be* embedded within the recess in the cover and in the protrusion/collar formed on the base.” [Emphasis added.] Applicant points out that in Neugebauer, the raised collar 36 extends about an aperture through the base for creating a friction fit with a counterbore in the cover surface, Neugebauer’s stated purpose of which is to temporarily maintain the card holder in a closed position *before* the threaded fastener or screw is inserted (see Neugebauer at column 3 lines 6-10).

In contrast, applicant’s holder is immediately maintained in a closed position by the attraction of the magnets, so that the Neugebauer holder does not suggest a motivation for providing a collar about one of applicant’s magnetic members and with the indentation extending about the other magnetic member as claimed in applicant’s dependent Claims 15, 42 and 55. Moreover, the Neugebauer collar does not provide a motivation for projecting an end portion of one of the Yeh or Yang magnets and for recessing the other of the Yeh or Yang magnets from the other surface, with an aligned indentation in one of the surfaces for receiving the magnet’s projecting end portion. The examiner’s elimination of the Neugebauer threaded screw and the examiner’s “*would be*” embedment of the Yang or Yeh magnetic members into the Neugebauer cover and base in a manner which he contends would result in applicant’s claimed invention comprises a non-permissible hindsight reconstruction of applicant’s invention. There is no suggestion, teaching or motivation in either Neugebauer, Yeh or Yang, nor has the examiner otherwise shown evidence of such a suggestion, teaching or motivation, to combine the Yeh or Yang references with the Neugebauer reference for supporting an obviousness rejection “Combining prior art references without evidence of such suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. … The showing [of evidence of such a suggestion, teaching, or motivation] must be clear and particular.” *In re Dembicza*k, 50

USPQ2d 1614, 1617 (Fed.Cir. 1999). “Close adherence to [the motivation or suggestion to combine requirement] is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome where that which only the inventor taught is used against its teacher.’” *In re Dembicza*k, 50 USPQ2d at 1617, citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, (Fed.Cir 1983).

Accordingly, applicant submits that amended independent Claims 1, 38, 49 and 63 (and withdrawn amended Claim 24), as well as all pending claims depending from these amended independent claims, are patentable over Neugebauer in view of either Yeh or Yang.

Applicant further submits that several of applicant’s dependent claims recite separate grounds of patentability over their respective base claims. Specifically, dependent Claims 15, 42 and 55 recite applicant’s raised collar about one of applicant’s magnetic members with the indentation extending about the other magnetic member, structure not suggested by the combination of Neugebauer and Yeh or Yang, as discussed above. With regard to the examiner’s rejection of dependent Claims 16, 18, 43, 45, 56 and 58, applicant submits that the oval configuration of applicant’s collar and indentation recited in those claims and in new Claims 70, 74 and 77, as well as the non-circular configuration of applicant’s collar and indentation as claimed in new Claims 69, 73 and 76, is not merely a matter of choice as contended by the examiner. As discussed in applicant’s specification at page 11 line 21 through page 12 line 5, the non-circular and in particular the oval configuration of these elements provides an advantage over a circular configuration in that the tendency for rotation of the base and cover about the circular magnets is discouraged.

Applicant submits herewith objective evidence of non-obviousness, MPEP §1504.03, specifically the accompanying “Declaration Under 35 C.F.R. §1.132” of Kevin P. Higgins, Chief Financial Officer of applicant’s assignee Ultra Pro L.P. That Declaration sets forth and compares sales of Ultra Pro’s magnetic card holder (part #81575) and Ultra Pro’s 1-screw screw -down card holder (part #81139), evidencing commercial success of the magnetic card holder notwithstanding that the magnetic holder was priced 40.7% higher than the 1-screw screw-down holder. Applicant submits that the commercial success of Ultra Pro’s magnetic card holder #81575 – which is constructed in accordance with applicant’s claimed invention

shown in FIGs. 1-11 of the patent application drawings – is persuasive evidence that applicant has made an inventive contribution to the art as defined in applicant's present claims.

In view of the foregoing, applicant respectfully submits that present Claims 1-6, 13-19, 38-46, 49-59, 61 and 63-77 patentably distinguish over the references of record. Applicant further submits that independent Claims 1, 49 and 63 are generic to the species identified by the examiner as species II, III and IV, and applicant requests consideration by the examiner of the pending claims to such additional species.

Applicant requests that a Notice of Allowance be issued with respect to all pending claims in this application.

Respectfully submitted,

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